Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PAUL J. BRYAN

Appeal No. 2004-1447
Application No. 09/871,349

ON BRIEF

Before STAAB, NASE, and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

REMAND

We remand this application to the examiner for action as may be appropriate. Specifically, we remand this application to the examiner to (1) respond to the argument in the brief regarding claim 14; and (2) consider the patentability of claims 1 to 11 and 13 to 15 in light of the "printed matter" doctrine.

Issue (1)

Claims 11 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,998,736 to Elrod.[1] In the brief (Paper No. 7, filed May 22,2003), the appellant provides two groups in the Grouping of Claims section (p. 4), Group I - Claim 11 and Group II - Claim 14. In the argument section of the brief, the appellant separately argues claim 11 (pp. 4-8) and claim 14 (pp. 8-9). In the answer (Paper No. 8, mailed August 14, 2003), the examiner did not respond to the appellant's argument regarding claim 14. Instead, the examiner stated (p. 3) that "[t]he rejection of claims 11 and 14 stand or fall together because the appellant's brief does not include a statement that this grouping does not stand or fall together and reasons in support thereof."

Since the appellant's brief does include a statement that claims 11 and 14 do not stand or fall together and reasons in support thereof as required by 37 CFR § 1.192(c)(7) and (c)(8), we remand this application to the examiner to respond to the appellant's argument (brief, pp. 8-9) regarding claim 14.

[1] Claims 1 to 10 and 15 stand allowed. Claim 13 has been objected to as depending from a non-allowed claim. Claim 12 has been canceled.

Issue (2)

The "printed matter" doctrine as set forth in In re Ngai, 367 F.3d 1336 (Fed. Cir. 2004) and In re Gulack, 703 F.2d 1381 (Fed. Cir. 1983) is that printed matter must be functionally related to the underlying object to be accorded patentable weight. That is, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. The Gulack court pointed out, "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." 703 F.2d at 1387.

We remand this application to the examiner to consider the patentability of claims 1 to 11 and 13 to 15 in light of the "printed matter" doctrine.

SUMMARY

We hereby remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

REMANDED

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

COATS & BENNETT, PLLC
P O BOX 5
RALEIGH, NC 27602

JVN/jg